

USSN: 09/770,960
Atty. Docket No.: 10247
Amdt. dated November 3, 2003
Reply to Non-Final OA of August 4, 2003

REMARKS/ARGUMENTS

Claims 1-26 are all the claims pending in the application.

Applicants note with appreciation the Examiner's withdrawal of the finality of the prior Action, as well as the withdrawal of the rejections containing Balaji as the primary reference, as indicated at Sections 1-3, page 2, of the present Action.

Referring to Section 5, pages 2-3, of the Action, Claims 1-4, 7, 10-13, 16, 20, and 22-24 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,931,327 to Liu, *et al.* ("Liu").

Applicants respectfully traverse this §102 rejection.

During patent examination, a term in a claim is given its broadest reasonable interpretation consistent with the specification. The broadest reasonable interpretation, unless otherwise indicated, must also be consistent with the interpretation that those skilled in the art would reach.

Each of independent Claims 1 and 24-25 recites a "cold glue." Consistent with both the specification and the interpretation that would be applied by one of ordinary skill in the art, the term "cold glue" as recited in the present claims necessarily excludes the "cold seal adhesives" disclosed in Liu.

The term "cold glue" is understood by those of ordinary skill in the art as referring to a class of materials distinct from and not including "cold seals." Examples of cold glues are set forth at page 9, lines 7-20, of the specification. Cold seals, on the other hand, are rubber-based materials. Column 3, line 66, through column 4, line 11. Although cold glues and cold seals are adequately distinguished simply based on their composition (as noted herein above), it is also helpful to look at the different applications for cold glues and cold seals.

Cold seal adhesives are adhesives that are applied to a film and then dried slightly; they remain slightly tacky at room temperature. The operation is done at a converter. The end user, or packager, would then take the film with the slightly tacky cold seal and use it to wrap items that cannot be wrapped at high temperatures, *e.g.*, candy bars and ice cream. The sealing

USSN: 09/770,960
Atty. Docket No.: 10247
Amdt. dated November 3, 2003
Reply to Non-Final OA of August 4, 2003

mechanism for cold seal is pressure and very low temperature (~105°F), as opposed to a heat-sealed film running at 280°F.

Cold glues are wet glues. They are applied to a label. The label with wet glue is then applied to, e.g., a bottle.

Accordingly, Applicants respectfully request the withdrawal of this §102 rejection of Claims 1-4, 7, 10-13, 16, 20, and 22-24.

Referring to Sections 7-8, pages 4-6, of the Action, Claims 5-6 and 8 and Claim 9 are rejected under 35 U.S.C. § 103(a) by a combination of references that includes U.S. Patent 6,458,469 to DeLisio, *et al.* ("DeLisio") as a secondary reference.

Applicants respectfully traverse these §103 rejections.

DeLisio cannot be applied against the claims of the present application in a §103 rejection. In this regard, effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. §103 solely via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." MPEP §706.02(l)(1). This change to 35 U.S.C. § 103(c) applies to all utility applications filed on or after November 29, 1999.

DeLisio is prior art against the present application solely under §102(e). DeLisio issued on October 1, 2002, whereas the present application was filed January 26, 2001.

In addition, the following statement is sufficient evidence to establish common ownership of, or an obligation for assignment to, the same organization:

Application 09/770,960 and DeLisio were, at the time the invention of Application 09/770,960 was made, owned by ExxonMobil Chemical Company.

Accordingly, the withdrawal of these §103 rejections is respectfully requested.

Referring to Section 9, page 6, of the Action, Claims 14-15, 17-19 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Liu.

USSN: 09/770,960
Atty. Docket No.: 10247
Amdt. dated November 3, 2003
Reply to Non-Final OA of August 4, 2003

Applicants respectfully traverse this §103 rejection.

As stated previously, Liu does not disclose (anticipate) the claimed labels including a cold glue. Liu also fails to suggest (render obvious) the claimed labels.

In this regard, in order for Liu to render obvious the inventions of Claims 14-15, 17-19 and 21, it would have had to have been obvious to, among other things, modify Liu by substituting the cold seals disclosed in Liu with the presently claimed cold glues. A person of ordinary skill in the art, however, would never have modified Liu by replacing the cold seals of Liu with cold glues. As mentioned previously, cold seals are adhesives that are applied to a film and remain slightly tacky at room temperature. The film with the slightly tacky cold seal is used to wrap items that cannot be wrapped at high temperatures, *e.g.*, candy bars and ice cream. Cold glues would be completely useless for applications that require cold seals.

Furthermore, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984). Applying the law to the facts of the present case, there can be no suggestion or motivation to modify Liu and arrive at the claimed invention because using cold glues on Liu's films would render Liu's films unsatisfactory for their intended purpose.

Accordingly, the withdrawal of this §103 rejection is requested.

Finally, referring to Section 10, page 7, of the Action, Claims 25-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,897,722 to Bright in view of U.S. Patent 5,194,324 to Poirier.

Applicants respectfully traverse this §103 rejection.

Poirier teaches the advantage of including a first high gloss medium density polyethylene (MDPE) on a surface of a cavitated core layer. Poirier is not particular about the adhesive-receiving skin layer on the side of the core layer opposite the high gloss MDPE. The Examiner points out column 2, lines 59-60, but this disclosure merely states that a MDPE skin layer is coextruded onto a surface of a cavitated core. It says nothing about the adhesive-receiving skin

USN: 09/770,960
Atty. Docket No.: 10247
Amdt. dated November 3, 2003
Reply to Non-Final OA of August 4, 2003

layer. At column 3, lines 5-6, Poirier discloses that the adhesive-receiving skin layer can be a non-cavitated polypropylene.

In contrast, the advantages of a label according to the inventions of Claims 25 and 26 are comprehensively demonstrated by the Examples presented at pages 14-19 of the specification, including the various tables therein. The advantages are also generally summarized at page 6, lines 7-15. The disclosed advantages are completely unexpected from Poirier or the combination of Bright and Poirier. The demonstration of unexpected results serves to rebut any alleged case of obviousness.

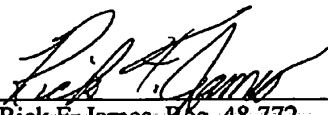
Furthermore, an applicant may compare the claimed invention with prior art that is closer to the invention than the prior art relied upon by the Examiner. The examples set forth in the present specification represent a comparison of representative examples of the invention of Claims 25 and 26 with prior art that is closer to the invention of Claims 25 and 26 than any actual embodiment or working example disclosed in Bright or Poirier. For example, Applicants kindly invite the Examiner to compare the results achieved by Examples 3, 6, and 9, which include an HDPE adhesive-receiving layer, and the results achieved by representative examples of the invention of Claims 25 and 26, such as Examples 4-5.

Accordingly, the withdrawal of this §103 rejection is requested.

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, she is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

Date: November 3, 2003


Rick F. James, Reg. 48,772

Post Office Address (to which correspondence is to be sent)
ExxonMobil Chemical Company
Law Technology
P.O. Box 2149
Baytown, Texas 77522-2149
Telephone Number (281) 834-2438
Facsimile Number (281) 834-2495